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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/652,620	09/02/2003	Jack A. Marmorstein	028788.0102-US00	1037
26853	7590	10/25/2005		
COVINGTON & BURLING ATTN: PATENT DOCKETING 1201 PENNSYLVANIA AVENUE, N.W. WASHINGTON, DC 20004-2401			EXAMINER MOSSER, KATHLEEN MICHELE	
			ART UNIT	PAPER NUMBER
			3715	

DATE MAILED: 10/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/652,620	Applicant(s) MARMORSTEIN ET AL	
	Examiner Kathleen Mosser	Art Unit 3715	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-86 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-86 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/27/04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Drawings

1. The drawings were received on 01/23/2004. These drawings are accepted as formal and proper.

Information Disclosure Statement

2. The information disclosure statement filed 12/27/2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. The examiner notes, that all references which were provided and the US references have been considered. The only reference not considered are the foreign reference(s) not provided.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-25, 27, 30-41, 43-66, 72, 73, and 75-86 are rejected under 35 U.S.C. 101 because the claimed invention lacks the claimed invention is directed to non-statutory subject matter. Regarding claims 1-22, for a method claim to be statutory it must produce a useful, concrete and tangible result. In the current claims the method is only directed to the displaying/presenting of information without any alteration of the data, steps performed on the data or calculation. The claimed steps are merely a manipulation of an abstract idea, which results in them being non-concrete. The same applies to the method associated with claims 43-64, although this method is recorded on a computer readable medium, the same conditions must be met.

Regarding claims 65, 66, 72, 73, and 75-86, the claims are recited in means plus function language. In the specification the applicant states that a sheet of paper may be used to match this

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functionality. Under this embodiment the claims are merely drawn to printed information on a page which constitute an arrangement of printed matter. A mere arrangement of printed matter, though seemingly a "manufacture," is rejected as not being within the statutory classes. See *in re Miller*, 418 F.2d 1392, 164 USPQ 46 (CCPA 1969); *EX part Gwin*, 112 USPQ 439 (Bd. App. 1955); and *In re Jones*, 373 f.2d 1007, 153 USPQ 77 (CCPA 1967). In the present application, the claimed printed matter se-forth à mere arrangement of printed matter that is not functionally related to the substrate and, therefore, does not distinguish the invention from prior art in terms of patentability. Although printed matter must be considered, in this situation, it is not entitled patentable weight. The printed matter claimed herein conveys no meaningful information in regard to the substrate, which they are arranged on and do not require any size relationship of the substrate, and do not require any particular substrate to effectively convey the information. Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is no-statutory subject matter. This same interpretation applies to system claim 23 and its dependents, where the description presentation apparatus is a book and the presenting steps are performed through print on the pages. Claims 27, 28-29, 42, 67-71 and 74 include elements, which preclude this interpretation of the claims, and are therefor not rejected under this statute.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 23-63 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Regarding claim 23, the claim although recited as a structural component is analogous to a single means claim (i.e. a description presentation apparatus), where a means recitation does not appear in combination with another recited element of means, is subject to undue breath

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rejection. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983). It is noted that in the specification the apparatus is a computer screen, a piece of paper, or any other display, and the scope of the claimed presentation apparatus, the only means in the claim, covers every conceivable structure for achieving the stated property (displaying information), is held non-enabling for the specification discloses at most only those known to the inventor. Dependent claims 24-63 do not correct this issue or add other structural elements to the claim and are rejected for the same reasons.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-12, 23, 24, 29, 31, 43-54 and 65-76 are rejected under 35 U.S.C. 102(b) as being anticipated by Bishop (US 5810599). Bishop teaches a display presentation display, specifically a computerized system with a video display and computer readable medium, which performs the steps of: presenting a first description of an event responsive to a first perspective (the audio visual work); and presenting a second description of the event responsive to a second perspective (the transcript) wherein the first and second description of the event are in the same language, as in **claims 1, 23, 43 and 65**. The event is displayed as an audio-visual work which is by definition a visual representation of the event, as in **claims 2, 24, 44, and 66**. Regarding **claims 3-9, 45-51 and 67-73**, the audio-visual work presents the audio components of the claims and the transcript presents the textual components of the claims, see at least col. 8: 40-6. These pieces are displayed on a computer monitor and simultaneously, as in **claims**

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10, 11, 29, 52, 53, 74 and 75. The event includes and interaction between a first individual and a second (claims 12, 31, 54, and 76), as is shown in at least col. 9: 54 – col. 10: 18.


Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
- a. Barras (US 2003/006969 A1)- teaching an electronic display device
 - b. Fisher (US 2001/0041328 A1) teaches a language immersion learning system
 - c. Bajer et al (US 6736642) teaches a system for training people regarding the assumptions they make
 - d. Block et al (US 6305942) teaches an immersion based learning system

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen Mosser whose telephone number is (571) 272-4435. The examiner can normally be reached on M-F 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on (571) 272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kathleen Mosser
Patent Examiner
Art Unit 3715

October 21, 2005